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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/720,825      | 11/24/2003  | Craig L. Reding      | 03-1025             | 5353             |

32127 7590 02/06/2006

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EXAMINER

PHAN, HUY Q

ART UNIT PAPER NUMBER

2687

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/720,825             | REDING ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Huy Q. Phan            | 2687                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is in response to Amendment filed on date: 01/09/2006.

Claims 1-7 and 9-15 are still pending.

Claim 15 is newly added.

Claim 8 is cancelled.

### ***Response to Arguments***

2. Applicant's arguments filed 01/09/2006 have been fully considered but they are not persuasive.

a) In response to Applicant's arguments with regard to the rejection of claims 1 and 12, under 35 U.S.C. 102(e) as being anticipated by Moran et al. (US-2003/0104827).

Applicant stated that "Moran does not, however, describe any systems or methods that include elements related to a "preferred device" of a user. For example, Moran does not describe receive any selections of a preferred device from a user, any determinations as to what device is a user's preferred device, or any routing of an SMS message to the preferred device of a receiving user...Moran does not teach or suggest "determining the preferred device for receiving messages" as recited in claim 1... Moran does not however further describe receiving SMS message to a device, determining the preferred device for receiving messages, and then sending the formatted message to the preferred device, as require by claim 1". While, Moran clearly discloses "the user

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may desire to send the text message to a PDA device (e.g., palm pilot), a handheld computer, or a PC e-mail account rather than a wireless phone or pager. In these instances, the user will generally have registered one or more of these types of devices with rerouting/reformatting service 70, and device IDs for those devices will be stored in database 82. Accordingly, the selected device may be determined based on indicia in the prefix of the e-mail address in optional combination with the sending device phone number or other indicia contained in e-mail message 75 or the e-mail address (see paragraph [0036])... Based on the service provider(s), the capabilities of the destination device, and any preferences entered by the user, data extractor and message reformatter 96 will reformat e-mail message 75 in a block 114 to produce a destination message 98. In more detail, destination message 98 will be reformatted, as necessary, based on the capabilities of the destination device stored in the device capabilities table 90, preferences entered by the user stored in rule definitions table 85, user table 86, and/or device capabilities table 90, and rules for the service provider that preferably are stored in provider rules table 83 and/or rule definition table 85 rules table 84. Generally, destination message 98 will comprise an SMS message, an e-mail message, or an instant message (see paragraph [0038])... For instance, if the message is to be received as a text message by a wireless destination device such as a wireless phone 15 or a pager 87 and the service provider is AT&T wireless, the message will be formatted to correspond with any applicable protocol required by the SMS messaging services provided by AT&T wireless, and forwarded to AT&T wireless SMSC 16, along with the phone number for the destination device, whereupon AT&T wireless SMSC 16

will send the message to the destination device via a wireless antenna 74 (see paragraph [0039]).

b) In response to Applicant's arguments with regard to the rejection of claim 9, applicant stated that "Moran does not teach or suggest "a server function for determining the preferred device" as recited in claim 9... Moran does not however further describe receive SMS message to a device, determining the preferred device for receiving messages, and then sending the formatted message to the preferred device. As such, Moran does not describe any elements that determine the preferred device, or send the SMS message to the preferred device, as required by claim 9". While, Moran particularly discloses "the user may desire to send the text message to a PDA device (e.g., palm pilot), a handheld computer, or a PC e-mail account rather than a wireless phone or pager. In these instances, the user will generally have registered one or more of these types of devices with rerouting/reformatting service 70, and device IDs for those devices will be stored in database 82 (described as "server"). Accordingly, the selected device may be determined based on indicia in the prefix of the e-mail address in optional combination with the sending device phone number or other indicia contained in e-mail message 75 or the e-mail address (see paragraph [0036])... In more detail, destination message 98 will be reformatted, as necessary, based on the capabilities of the destination device stored in the device capabilities table 90, preferences entered by the user stored in rule definitions table 85, user table 86, and/or device capabilities table 90, and rules for the service provider that preferably are stored in provider rules table 83 and/or rule definition table 85 rules table 84. Generally,

destination message 98 will comprise an SMS message, an e-mail message, or an instant message (see paragraph [0038])... For instance, if the message is to be received as a text message by a wireless destination device such as a wireless phone 15 or a pager 87 and the service provider is AT&T wireless, the message will be formatted to correspond with any applicable protocol required by the SMS messaging services provided by AT&T wireless, and forwarded to AT&T wireless SMSC 16, along with the phone number for the destination device, whereupon AT&T wireless SMSC 16 will send the message to the destination device via a wireless antenna 74 (see paragraph [0039]).

With all the reasons stated above, the rejection is deemed proper and still stands.

### ***Claim Objections***

3. Claims 11 and 14 are objected to because of typographical errors.

In claim 11, line 1, "8" should be changed to - -9- -.

In claim 14, line 1, "8" should be changed to - -12- -.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Moran et al. (US-2003/0104827).

Regarding claim 1, Moran et al. disclose a method for providing SMS messages to a user (fig. 2A and description) having a plurality of devices including a preferred device ([0009]-[0012]), the method comprising:

receiving a SMS message for one of the plurality of devices ([0033]-[0036]);

determining the preferred device for receiving messages [0036];

formatting the SMS message according to characteristics of the preferred device ([0030]-[0038]); and

sending the formatted message to the preferred device ([0038]-[0040]).

Regarding claim 2, Moran et al. disclose the method of claim 1, wherein sending the formatted message comprises sending the formatted message to a SMS-capable device ([0038]-[0040]).

Regarding claim 3, Moran et al. disclose the method of claim 1, wherein sending the formatted message comprises sending the formatted message to an e-mail address ([0034]-[0036]).

Regarding claim 4, Moran et al. disclose the method of claim 1, wherein sending the formatted message comprises sending the formatted message to an instant messenger client [0038].

Regarding claim 5, Moran et al. disclose the method of claim 1, wherein sending the formatted message comprises sending the formatted message to a phone [0039].

Regarding claim 6, Moran et al. disclose the method of claim 1, wherein sending the formatted message comprises sending the formatted message to digital companion client software ([0039]-[0041]).

Regarding claim 7, Moran et al. disclose the method of claim 1, comprising: storing messages in a database when the user's preferred device is not available to receive messages ([0028]-[0029]).

Regarding claim 9, Moran et al. disclose an apparatus (fig. 2A and description) for providing SMS messages to a user having a plurality of devices including a preferred device ([0036]-[0040]), comprising:

a database for storing a specification of a preferred device ([0028]-[0029] and [0036]-[0038]);

a gateway server for receiving a SMS message sent to one of the user's devices ([0034]-[0035]);

a server function for determining the preferred device [0036]; and  
a SMS server for sending the SMS message to the preferred device ([0038]-[0040]; also see fig. 2A and description).

Regarding claim 10, Moran et al. disclose the apparatus of claim 9, wherein the SMS server comprises a server that stores messages to a database when the user's preferred device is not available to receive messages ([0028]-[0029]).

Regarding claim 11, Moran et al. disclose the apparatus of claim 9, wherein the SMS server comprises a server that formats the SMS message in accordance with characteristics of the preferred device before sending the message to the preferred device ([0036]-[0040]).

Regarding claim 12, Moran et al. disclose an apparatus for providing SMS messages to a user (fig. 2A and description) having a plurality of devices including a preferred device ([0036]-[0040]), comprising:

means for storing a specification of a preferred device ([0028]-[0029]);  
means for receiving a SMS message sent to one of the user's devices ([0034]-[0035]);  
means for determining the preferred device [0036]; and  
means for sending the SMS message to the preferred device ([0038]-[0040]; also see fig. 2A and description).

Regarding claim 13, Moran et al. disclose the apparatus of claim 12, wherein the means for sending the SMS message comprises means for storing messages to a database when the user's preferred device is not available to receive messages ([0028]-[0029]).

Regarding claim 14, Moran et al. disclose the apparatus of claim 12, wherein the means for sending the SMS message comprises means for formatting the SMS message in accordance with characteristics of the preferred device before sending the message to the preferred device ([0036]-[0040]).

Regarding claim 15, Moran et al. disclose a method ([0036]-[0040]), comprising:  
receiving a plurality of identifier associated with a respective plurality of devices [0036];

storing the plurality of identifiers in a user profile associated with a user [0036];  
receiving a selection of a preferred device "selected device" of the plurality of devices [0036];

receiving a specification of characteristics of the preferred device [0038];  
receiving an SMS message having a destination identifier ([0038]-[0040]);  
determining the SMS message is addressed to the user when the destination identifier is one of the plurality of identifiers ([0038]-[0040]);

when the SMS message is addressed to the user [0038], determining an identifier of the preferred device [0036], and formatting the SMS message based on the specification of characteristics of the preferred device and including the identifier of the preferred device [0038], and sending the formatted SMS message to the preferred device ([0036]-[0040]).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Thompson discloses "the invitation may be forwarded to the team member by formulating a text-based invitation message suitable for display by the selected communications device, and sending the text-based invitation message to the selected communications device" (see specification).

b) Karve discloses "The forwarding address database stores phone numbers that may be selected by the user such that received short messages are forwarded to the selected address" (see specification).

6. **THIS ACTION IS MADE FINAL.**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

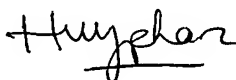
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid G Lester can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Examiner: Phan, Huy Q.

  
SONNY TRINH  
PRIMARY EXAMINER

AU: 2687

Date: 01/30/2006